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09/762,572	02/08/2001	Angela Speith-Herfurth	6001-0110	5054

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THOMAS T. MOGA
DICKINSON WRIGHT, PLLC
1901 L STREET NW, SUITE 800
WASHINGTON, DC 20036

EXAMINER

TARAZANO, DONALD LAWRENCE

ART UNIT	PAPER NUMBER
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1773

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DATE MAILED: 06/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/762,572

Applicant(s)

SPEITH-HERFURTH ET AL.

Examiner

D. Lawrence Tarazano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-18, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-18, and 20-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other:

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10, 12-18, and 20-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 and 20-32 of copending Application No. 09/601,790 in view of Dries et al. (5,529,843).

This is a provisional obviousness-type double patenting rejection.

2. The applicants claim polypropylene films comprising wax, in which claim 11 claims that the base layer can also comprise hydrocarbon resin. The copending application claims polypropylene resin, wax, and hydrocarbon resin as a mixture. The examiner relies upon Dries et al. to show that hydrocarbon resins can be added to the base layer or interlayers of polypropylene in the art of polypropylene films (column 6, lines 50+). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have added resin to the polypropylene layer containing wax since hydrocarbon resin can be added to various layers in polypropylene film and there does not appear to be any criticality to the location of the material as far as internal layers go.

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3. The filed terminal disclaimer is defective since the attorney signing the document is not of record.

Claim Objections

4. Claims 1 and 21 are objected to because of the following informalities: The word “propylen” is misspelled. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-5, 7-9, 10, 12, 13, 16, 17, 18, 20, 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Chu et al. (6,159,612).

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7. Chu et al. teach 5 layer films (A/B/C/B/A) having intermediate layers comprising a blend of polypropylene and wax. The wax materials have molecular weights between 300 and 800, preferably 300 to 450 (column 2, lines 45-55). The examples show that layers (B) have thickness of about 4.3 microns, and a wax concentration of at least 10%, in which the example shows amounts of 15%.

The claimed molecular weights of the waxes are relatively low. The examiner takes the position that the molecular weight distribution of the materials taught by Chu et al. would be low. As molecular weights go down, it is easier to measure them in an accurate manner so there would be smaller differences in the results obtained from different methods: ergo, low molecular weight distribution.

The applicants state that the surface layers of their film are heat-sealable, while Chu et al. is silent regarding the sealability of the surface layers, they are made from olefin polymers similar to the ones cited by the applicants in their specification so there is reason to believe that they would be sealable as claimed (column 3, lines 28-42).

The films are coated with a coating comprising finely divided inorganic materials, so it would have a matte finish as claimed.

The applicants claim (claim 10), that the base layer has an isotactic polypropylene having an isotactic index of at least 95%. The higher the melting point of a polypropylene material the more crystalline it is and the isotactic index is directly related to the crystallinity of the resin. Since Chu et al. use highly isotactic materials having low heptane extractables and high melting points (above 150 deg), there is reason to believe that they use the types of materials claimed (column 2, lines 1+).

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Chu et al. use standard additives (column 4), which correspond to what the applicants use. This includes low molecular weight resins as claimed. Since these materials are used as additives, they would be used in low amounts as claimed (The 1-20% range claimed is a wide range for an additive).

Regarding claim 18, the films are stretched 4.5 to 6 times in the machine direction and 6-13 times in the transverse direction (column 6, lines 4-12). Finally films of this type are used in packaging applications as claimed.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-5, 7-10, 12-18, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chu et al (6,159,612) in view of Bothe et al. (5,254,394).

Chu et al. as discussed above teaches the applicants' basic structure but they are silent regarding the isotacticity of the isotactic polypropylene and neither teaches the addition of hydrocarbon resins as claimed.

Bothe et al. teach that polypropylene having an isotacticity of greater than 95% and melting points of greater than 140 deg C, preferably greater than 150 deg C (claims 2 and 22, and column 2, lines 24-42) are used in the production of films. The examiner maintains that the

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isotactic polypropylene materials used by Chu et al. are the same as those claimed, or it would have been obvious to use the isotactic polypropylene materials having isotactic indexes above 95% described in Bothe et al. since they have the high melting points required by the primary references.

Bothe et al. show that hydrocarbon resins are added to the inner or surface layer of packaging films (column 4, lines 6+) to improve the properties of the films.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have added conventional additives such as those discussed in Bothe et al. for their known and expected function, including the addition of hydrocarbon resins, in order to improve the properties of the films taught by Chu et al.

The term “syndiotactic polypropylene” is generic and would include both homopolymer and copolymers.

Regarding claims 20 and 21 the films taught are used in packaging applications.

Response to Arguments

10. Applicant's arguments filed 3/31/2003 have been fully considered but they are not persuasive.

11. The applicants state that Chu et al. require syndiotactic polypropylene in the barrier layer. The applicants' claims are directed to “isotactic polypropylene, a propylene copolymer, or a propylene terpolymer”. The examiner notes that the term “isotactic” is only directed to the claimed homopolymers so it does not preclude “syndiotactic” propylene materials having even minor amounts of comonomer. Chu et al. does not appear to be strictly limited to

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“homopolymer”. Furthermore, amounts of comonomer could be added in such small amounts that the properties of the material would not be different from that of homopolymer.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Lawrence Tarazano whose telephone number is (703)-308-2379. The examiner can normally be reached on 8:30 to 6:00 (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on (703)-309-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9310 for regular communications and (703)-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0661.

D. Lawrence Tarazano
Primary Examiner
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A handwritten signature in black ink, appearing to be 'DL' with a horizontal line above it, enclosed in a semi-circular flourish.

dlt
June 13, 2003